UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,645	11/05/1999	DAVID B. LOEPER	D5009-00002	4199

8933 7590 09/08/2004

DUANE MORRIS, LLP
IP DEPARTMENT
ONE LIBERTY PLACE
PHILADELPHIA, PA 19103-7396

EXAMINER	
KYLE, CHARLES R	

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/434,645	LOEPER, DAVID B.	
	Examiner	Art Unit	
	Charles R Kyle	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7,9-13 and 15-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7,9-13 and 15-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner's Note

The Examiner notes that Claims 2, 8 and 14 are referred to as "withdrawn" in Applicant's preceding listing of Claims. As there has been no restriction requirement =in the case, it is assumed that Applicants intends that these Claims are cancelled. The Claims remaining are treated now to expedite prosecution.

Claim Rejections - 35 USC § 101

The rejection of Claims 1-12 under 35 USC § 101 are withdrawn based on Applicant's amendment. A review of the Specification reveals that the term "processor" specifically denote a computer processor which imparts a technological element to the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-7, 9-13 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jones et al* in view of *Jones et al* in view of *Birwirth et al*, both of record.

As to Claim 1, *Jones* discloses the invention substantially as claimed as in a method for evaluating financial plans (Abstract) the steps of:

Receiving from a user financial plan information, comprising a predetermined initial value of an investment (Col. 18, lines 27-29), at least one predetermined contribution amount at a predetermined contribution time (Col. 18, line 21 and Col. 18, lines 43-48), at least one predetermined withdrawal amount at a predetermined withdrawal time subsequent to the predetermined contribution time (Col. 22, lines 56-60) and a plan duration (Col. 17, line 36-43 and Col. 18, lines 27-28);

Presenting calculated investment values using results of said steps (Col. 20, lines 7-30)

Wherein said steps of calculation are implemented by a processor (Fig. 1; Col. 7, lines 11-60; Col. 20, lines 7-30).

Jones does not specifically disclose the detail of simulating historical performance of a portfolio to analyze financial plans. *Birwirth* discloses these particular features as follows:

Selecting a first historical commencement date for a simulation of performance of a financial plan consistent with financial plan information (Page 3, lines 24-26);

Using historical market data commencing from said first historical commencement date, calculating the changes in said predetermined initial value of an investment for each time period in one or more series of successive historical time periods including allowing for said predetermined contribution amount and said predetermined withdrawal amount continuing until an expiration of the plan duration (Page 3, lines 35-38); and

Selecting a plurality of second historical commencement dates and repeating the foregoing steps of calculation commencing with each of said second historical commencement dates (Page 3, lines 29-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the financial plan analysis of *Jones* with the historical analysis of *Birwirth* because of the improved performance resulting from this historical approach. These benefits are specifically set out by *Birwirth* as follows. *Birwirth* describes problems with unrealistic assumptions of traditional financial plans at the last paragraph of page 1 and describes the solution to this problem as using the historical investment experience of others to produce more realistic and useful retirement modeling. See particularly the Conclusion at page 6 of Birwirth.

Additionally, the steps of receiving and allowing for initial investment, contributions, withdrawals and a plan duration cannot confer patentability because the replicate the steps involved in the retirement ledger disclosed by *Birwirth* at page 1, line 16 to page 2, line 51. The concepts recited here are similar to those of another well-known financial activity, balancing a checkbook at the end of the month.

Regarding Claims 3, 9 and 15, *Bierwirth* discloses the invention substantially as claimed. See the discussions set forth above. *Bierwirth* does not specifically disclose allocation to more than one asset category. Jones et al disclose multiple asset categories and distinct historical data at Fig. 4 and Col. 12, line 54 to Col. 13, line 41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the multiple asset categories of *Jones* in the invention of *Bierwirth* because this would have allowed investors

to flexibly study varying combinations of investments in an attempt to maximize return on investment.

As to Claims 4, 10 and 16, *Bierwirth* disclose comparison of results of calculation to a goal at page 2, lines 31-41.

Concerning Claims 5, 11 and 17, Jones discloses adjustment for taxes at Fig. 3 and Col. 8, lines 1-13. Also, *Bierwirth* discloses adjustment for taxes at pages 5-6, "A Word About Taxes".

With respect to Claims 6, 12 and 18, Jones et al teach the entry of initial investment values and allocation to asset categories at Col. 5, line 50 to Col. Col. 7, line 10.

With respect to Claims 7 and 13, *Bierwirth* discloses the use of a computer system, which inherently uses a storage medium for executable instructions. See *Bierwirth* at page 3, lines 7-9. Additionally see the discussion of Claim 1 regarding the disclosure by *Jones* of a processor executing stored instructions.

Additionally, the steps of receiving initial investment, contributions, withdrawals and a plan duration cannot confer patentability because the replicate the steps involved in the retirement ledger disclosed by *Bierwirth* at page 1, line 16 to page 2, line 51. The concepts recited here are similar to those of another well-known financial activity, balancing a checkbook at the end of the month.

As to Claim 19, *Bierwirth* discloses identification of time intervals at result presentation at page 3, lines 21-33.

Concerning Claim 20, *Bierwirth* discloses having as a goal a specified sum after a number of years at page 2, lines 31-35.

Regarding Claim 21, Jones et al disclose changing an asset allocation after a selected number of time intervals and using a changed allocation in subsequent calculations at Col. 12, lines 24-28.

As to Claim 22, *Jones* discloses plural withdrawal amounts at plural times at Col. 20-62.

Response to Arguments

Applicant's arguments filed June 10, 2004 have been fully considered but they are not persuasive.

At page 6 of Remarks, Applicant comments on the 35 USC 101 rejection; the rejection is withdrawn based on Applicant's amendment.

At mid-page 6, Applicant first generally discusses his invention preparatory to discussing the rejection over *Jones* in view of *Birwirth.* At page 7, Applicant comments that the results of *Jones* do not reflect real markets; *Birwirth* does reflect real historical markets and was relied upon for this concept. Applicant also fails to explain how his observation specifically relates to the claimed invention.

At the first paragraph of page 7, Applicant argues that *Jones* teaches away from the use of historical data. The Examiner notes that Applicant specifically admits that the use of historical data was known in the art well before the filing data of his Application. Applicant argues that *Jones* is concerned with "future-looking realistic economic and investment return scenarios." This is true and the same can be said of the disclosure of *Birwirth.* At Abstract, *Birwirth* specifically states that "By understanding the range of ***historical*** results, the client is

better able to make informed policy decisions regarding the ***future***. (Emphasis added). Thus *Jones* is directed to financial planning for the future, as conceded by Applicant, and *Birwirth* provides analysis of historical results to improve on such future financial plans. *Birwirth* specifically provides a motivation to combine with *Jones* and does not teach away. Further, such teaching away would have to be clearly set forth by a reference. A clear example, set forth at MPEP 2145 X.D.2, is as follows:

> *References Cannot Be Combined Where Reference Teaches Away from Thei rCombination*
>
> *It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.)*

Applicant asserts that "implicitly" *Jones* indicates that the use of historical data is undesirable but provides no evidence that this is so. Applicant discusses at length the complexity of the *Jones* method and argues that this teaches away, but provides no clear explanation of why complexity of the *Jones* reference would teach away. Applicant fails to explain why, the fact that returns might be "several steps removed from historical" data might indicate the incompatibility of the references. The combination is reasonable.

Further, Applicant neither identifies any limitation not disclosed by the references, nor provides any substantive refutation of the Examiner's motivation to combine. The Examiner understands this silence by Applicant to be assent to the correctness of the application of the art in the rejections.

As to Applicant's argument at top page 8 regarding the lack of use of historical modeling in *Jones*, the Examiner observes that there is a panoply of elements not disclosed by *Jones*, many

of which would, like the use of historical data, be obvious. The fact that *Jones* does not disclose the use of historical data in detail is hardly evidence that such data is incompatible with the modeling of *Jones*.

As to Applicant's argument about a lack of suggestion to combine in *Birwirth*, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves ***or in the knowledge generally available to one of ordinary skill in the art***. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant states that the two references take entirely different approaches to argue against their combination. The Examiner disagrees. Both references are concerned with retirement planning and would logically use similar systems and methods. See *Jones* at Background of the Invention and *Birwirth* at Abstract.

At the last paragraph of page 8 of the Remarks Applicant argues that *Birwirth* lacks several features for which the Examiner relied upon *Jones*. The combination of the references was used to reject the Claims, not just *Birwirth*.

At page 9, Applicant again argues differences between the references but fails does not explain specifically why they would be incompatible. It is axiomatic in investing that past performance does not guarantee future results, but one who invests without seeing what markets have done in the past is merely guessing about the future. Use of the historical information

disclosed by *Birwirth* in the investment planning method of *Jones* would not only be obvious but also simply prudent.

The rejections are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

crk
August 26, 2004

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600